

### **REMARKS**

Applicant respectfully requests reconsideration of the present application in view of the foregoing amendments and in view of the reasons that follow. After amending the claims as set forth above, claims 1-9 and 11-12 are now pending in this application.

Applicant wishes to thank the Examiner for the careful consideration given to the claims.

#### **Information disclosure statement**

An information disclosure statement (IDS) was filed with the PTO on September 27, 2007. It is respectfully requested that the Examiner consider the IDS, and return a copy of the initialed and signed IDS to the Applicant in the next office communication.

#### **Claims objections**

Claims 2-12 are objected to because of the phrase “the other of the driven member and the drive member.” Although Applicant believes the claims are clear in this regard, claims 2-5 and 7 have been amended to recite “the other of the driven member and the drive member that remains engaged with the link.” Also claim 10 had been cancelled. For at least these reasons, favorable reconsideration of the rejection is respectfully requested.

#### **Rejection of claims 1-9 and 11-12 based on Skrobisch**

Claims 1-8 and 11-12 are rejected under 35 U.S.C. 102(b) as being anticipated by U.S. Patent 4,825,992 (“Skrobisch”). Claim 9 is rejected under 35 U.S.C. 103(a) as being unpatentable over Skrobisch. For at least the following reasons, these rejections are traversed.

Claims 1 (as amended) recites a power transmission for a compressor including, among other things, “a first engagement member fixed to the one of the driven member and the drive member; wherein said link has a hole at one end portion thereof and an open end slot at the other end portion thereof which releasably receives said first engagement member.” Skrobisch does not teach or suggest these features.

Skrobisch relates to a magnetic torque limiting clutch having an overload disconnection means. Skrobisch discloses a torque limiting clutch comprising a circular driven output plate or disk 70 which has a plurality of circumferentially spaced fingers 72, a hub 26 which is driven by a motor (not shown), a cylindrical permanent magnet 19, and a plurality of keeper plates 52. (Column 2, line 34 to column 3, line 14 of Skrobisch.) Each keeper plate 52 has a recess 50 on one end and a central slot 56 on the other end defining two

spaced legs 58. (Column 2, lines 60-66 of Skrobisch.) Each keeper plate also is rotatable on a pin 46 and the legs 58 are magnetically attracted to annular coplanar end faces 60 and 62 of the magnetic rings 12 and 14. (Column 2, lines 60-66 of Skrobisch.) In operation, the keeper plates 52 will be disposed in radial positions such that they abut against the fingers 72 of the power output disk 70. (Column 3, lines 15-26 of Skrobisch.) The force of magnetic attraction multiplied by the coefficient of friction of the keeper plates against the ring faces 60 and 62 determines the minimum force required to cause the keeper plates to start slipping. (Column 3, lines 15-26 of Skrobisch.) However, Skrobisch does not teach a link that has a hole at one end portion thereof and an open end slot at the other end portion thereof which releasably receives said first engagement member. Indeed, the slot 56 of Skrobisch does not receive any member. Accordingly, Skrobisch does not teach or suggest all the features of claim 1.

Claims 2-9 and 11-12 depend from and contain all the features of claim 1, and are allowable for the same reasons as claim 1, without regard to the further patentable features contained therein.

For example, claim 9 recites “wherein the link includes plates of an identical shape and dimension stacked on each other.” Skrobisch does not teach or suggest these features. The PTO asserts that “[i]t has been held that mere duplication of the essential working parts of a device involves only routine skill in the art.” *St. Regis Paper Co. v. Bemis Co.*, 193 USPQ 8. It would have been obvious...to provide a link composed of a stack of identically shaped plates to increase the durability and strength of the link.” (Paragraph 6 of the Office Action.) The rejection is improper. First, to establish a *prima facie* case of obviousness, the prior art must teach all the features of the claimed invention (See MPEP 2143.03<sup>1</sup>) and the Supreme Court in *KSR Int’l Co. v. Teleflex, Inc.* has not removed this requirement. Quite the contrary, the Court in *KSR* emphasized cases where all features are known.<sup>2</sup> As to the assertion that *St. Regis Paper* teaches that the mere duplication of the essential workings part

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<sup>1</sup> “To establish *prima facie* obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art. *In re Royka*, 490 F.2d 981, 180 USPQ 580 (CCPA 1974).”

<sup>2</sup> For example, the Supreme court stated that “a patent composed of several elements is not proved obvious merely by demonstrating that each of its elements was, independently, known in the art...it can be important to identify a reason that would have prompted a person of ordinary skill in the relevant field to combine the elements in the way the claimed new invention does.” 127 S.Ct. 1727, 1741 (decided April 30, 2007). Also, the Supreme court noted three cases *United States v. Adams*, 383 U.S. 39 (1966), *Anderson’s-Black Rock, Inc. v. Pavement Salvage Co.*, 396 U.S. 57 (1969), and *Sakrinda v. AG Pro, Inc.*, 425 U.S. 273 (1976) which all dealt with the issue of whether known elements combined together would be obvious. These statements reinforce the concept that the elements of the claim have to be known in the art before they are determined to be combinable or not.

of a device involves only routine skill in the art, *St. Regis Paper*<sup>3</sup> does not provide such a holding. The invention in *St. Regis Paper* was a bag of tubular form consisting of several contiguous layers of flexible sheet material. *Id.* at 834. The difference between the claimed bag in the patent at issue and the prior art was the use of hot melt adhesive and the progressive stepping of the plies. *Id.* at 839. As to the former, it was admitted by the patentee that hot melt adhesive is well known in the art. *Id.* As to the latter, the concept of stepping the plies of a multilayered bag was disclosed in the prior art.<sup>4</sup> *Id.* Thus, *St. Regis Paper* is a case in which the prior art disclosed all the elements of the claimed invention, which is not the case here. Further, the court in *St. Regis Paper* does not state that the use of multiple layers is a mere duplication of parts. Thus, reliance on *St. Regis Paper* as a basis for the grounds of rejection is misplaced, and it is no substitute for the requirement to provide prior art that teaches all the features of the claimed invention. Accordingly, claim 9 is not rendered unpatentable over Skrobisch for at least this additional reason.

For at least these reasons, favorable reconsideration of the rejections is respectfully requested.

Rejection of claims 1-8 and 11-12 based on Skrobisch and Hatakeyama

Claims 1-8 and 11-12 are rejected as being obvious over Skrobisch in view of U.S. Patent 5,944,156 (“Hatakeyama”). For at least the following reasons, this rejection is traversed.

Claims 1 (as amended) recites a power transmission for a compressor including, among other things, “a first engagement member fixed to the one of the driven member and the drive member; wherein said link has a hole at one end portion thereof and an open end slot at the other end portion thereof which releasably receives said first engagement member.” As previously mentioned, Skrobisch does not teach or suggest these features because the slot 56 of Skrobisch does not receive any member. Hatakeyama does not cure the deficiencies of Skrobisch.

Hatakeyama relates to a power transmission mechanism for use in a compressor. Hatakeyama discloses a power transmission mechanism comprising a pulley 1, a shaft 4, a hub 5 provided with holding parts 6 in which each holding part accommodates a disk-like elastic member 2, and a holding disk 7 fixed to the shaft 4. (Column 4, lines 21-37 of

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<sup>3</sup> 549 F.2d 833 (7<sup>th</sup> Cir. 1977).

<sup>4</sup> French patent 1,227,176

Hatakeyama.) When an excessive torque, whose magnitude exceeds the predetermined value, is applied to the pulley 1, the deformation of each of the elastic members 2 is gradually enhanced by a compressive force applied from the pulley in a radial direction such that each of the elastic members 2 moves in the radial direction. (Column 2, lines 42-48 of Hatakeyama.) Then each of the elastic members 2 advances and is detached from a corresponding one of the holding portions 3 of the pulley 1. (Column 2, lines 48-50 of Hatakeyama.) Subsequently, each of the elastic members 2 passes through a restriction portion 8 provided in a corresponding one of the holding parts 6 of the hub 5. (Column 2, lines 51-53 of Hatakeyama.) Finally, each of the elastic members 2 is accommodated in the inner portion 9 of the holding part. (Column 4, lines 53-55 of Hatakeyama.) However, Hatakeyama does not teach or suggest a link that has a hole at one end portion thereof and an open end slot at the other end portion thereof which releasably receives said first engagement member.

Accordingly, no combination of Skrobisch and Hatakeyama teaches a power transmission with, among other things, the link of claim 1.

Claims 2-8 and 11-12 depend from and contain all the features of claim 1, and are allowable for the same reasons as claim 1, without regard to the further patentable features contained therein.

For at least these reasons, favorable reconsideration of the rejection is respectfully requested.

Applicant believes that the present application is now in condition for allowance. Favorable reconsideration of the application as amended is respectfully requested.

The Examiner is invited to contact the undersigned by telephone if it is felt that a telephone interview would advance the prosecution of the present application.

The Commissioner is hereby authorized to charge any additional fees which may be required regarding this application under 37 C.F.R. §§ 1.16-1.17, or credit any overpayment, to Deposit Account No. 19-0741. Should no proper payment be enclosed herewith, as by a check or credit card payment form being in the wrong amount, unsigned, post-dated, otherwise improper or informal or even entirely missing, the Commissioner is authorized to charge the unpaid amount to Deposit Account No. 19-0741. If any extensions of time are needed for timely acceptance of papers submitted herewith, Applicant hereby petitions for such extension under 37 C.F.R. §1.136 and authorizes payment of any such extensions fees to Deposit Account No. 19-0741.

Respectfully submitted,

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